UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/665,574	09/22/2003	Kazuo Takaoki	2185-0706P	6442

2292 7590 01/13/2005

BIRCH STEWART KOLASCH & BIRCH
PO BOX 747
FALLS CHURCH, VA 22040-0747

EXAMINER	
LEE, RIP A	

ART UNIT	PAPER NUMBER
1713	

DATE MAILED: 01/13/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/665,574	TAKAOKI, KAZUO	
	Examiner	Art Unit	
	Rip A. Lee	1713	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☐ Responsive to communication(s) filed on _____.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) 1-11 is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) 1-11 is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☒ All b)☐ Some * c)☐ None of:

1.☒ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date 12/22/03; 06/06/04.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.
>
> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

2. Claims 1-11 are rejected under 35 U.S.C. 102(e) as being anticipated by U.S. 2002/0143124 to Ogane.

Ogane teaches a modified particle prepared by a process comprising contacting a particle with a compound represented by the formula $M^1L^1_m$ and a compound represented by the formula $R^1_{t-1}TH$. Here, M^1 is a metal from groups I, II, XII, XIV, or XV, *m* is the valence of M^1, and L^1 is a hydrogen atom, a halogen, or a hydrocarbon group (see claim 3). Specifically, M^1 is a bismuth atom (paragraph [0035], line 9).† Element T represents an atom from group XV or XVI, and R^1 is an electron attracting (*i.e.*, electron withdrawing) group or a substituent containing an electron attracting group. Specifically, T is an oxygen atom (paragraph [0047], line 9). Illustrated embodiments of R^1 clearly contain halogenated hydrocarbon groups (see for instance paragraph [0052]; fluoromethyl, trifluoromethyl, *etc.*). When the metal M^1 is bismuth, naturally, *m* equals three (as recited in claim 4) since bismuth is trivalent.

A further aspect of the invention of Ogane is the preparation of a catalyst comprising the modified particle. In this case, the modified particle is contacted with an aluminoxane and a transition metal component (claims 6 and 7). Said transition metal component is a compound of a group 3-11/lanthanide metal (paragraph [0141]). Group 4 metallocenes are exemplary (see paragraph [0174]). Finally, the invention of the prior art is also drawn to a process for producing addition polymer using the catalyst described therein (claims 8, 11, and 12). The addition polymer is derived from olefins (paragraph [0219]), and the latter includes copolymers of ethylene with α-olefins (paragraph [0220] and [0221]). In summary, all aspects of the present claims are taught in the prior art of Ogane.

3. Claims 1-11 are rejected under 35 U.S.C. 102(a) as being anticipated by DE 101 64 188 to Ogane.

Ogane teaches a modified particle prepared by a process comprising contacting a particle with a compound represented by the formula $M^1L^1_m$ and a compound represented by the formula $R^1_{t-1}TH$. Here, M^1 is a metal from groups I, II, XII, XIV, or XV, *m* is the valence of M^1, and L^1 is a hydrogen atom, a halogen, or a hydrocarbon group (see claim 3). Specifically, M^1 is a bismuth atom (paragraph [0026], line 5).† Element T represents an atom from group XV or XVI,

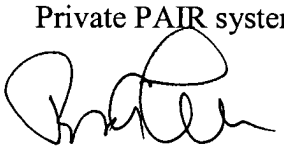
† A genus does not always anticipate a claim to a species within the genus. However, when the species is clearly named, the species claim is anticipated no matter how many other species are additionally named. *Ex parte A*, 17 USPQ2d 1716 (BPAI 1990). Here, the claimed compound was named in a reference which also disclosed forty-five other compounds. The Board held that the comprehensiveness of the listing did not negate the fact that the compound claimed was specifically taught. See also, *In re Sivaramakrishan*, 673 F.2d 1383, 213 USPQ 441 (CCPA 1982).

and R^1 is an electron attracting (*i.e.*, electron withdrawing) group or a substituent containing an electron attracting group. Specifically, T is an oxygen atom (paragraph [0037], line 5). Illustrated embodiments of R^1 clearly contain halogenated hydrocarbon groups (see for instance paragraph [0041]; fluoromethyl, trifluoromethyl, *etc.*). When the metal M^1 is bismuth, naturally, *m* equals three (as recited in claim 4) since bismuth is trivalent.

A further aspect of the invention of Ogane is the preparation of a catalyst comprising the modified particle. In this case, the modified particle is contacted with an aluminoxane and a transition metal component (claim 6). Said transition metal component is a compound of a group 3-11/lanthanide metal (paragraph [0111]). Group 4 metallocenes are exemplary (see paragraph [0139]). Finally, the invention of the prior art is also drawn to a process for producing addition polymer using the catalyst described therein (claims 4, 5, and 7). The addition polymer is derived from olefins (paragraph [0177]), and the latter includes copolymers of ethylene with α-olefins (paragraph [0178] and [0179]). In summary, all aspects of the present claims are taught in the prior art of Ogane.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Rip A. Lee whose telephone number is (571)272-1104. The examiner can be reached on Monday through Friday from 9:00 AM - 5:00 PM. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Wu, can be reached at (571)272-1114. The fax phone number for the organization where this application or proceeding is assigned is (703)872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on the access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll free).



ral

January 11, 2005